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IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			CERVETTI, DAVID GARCIA	
			ART UNIT	PAPER NUMBER
			2136	

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/915,665

Applicant(s)

BANERJEE ET AL.

Examiner

David G. Cervetti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-26 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 09 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/9/01.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

1. Applicant's arguments filed April 13, 2005, have been fully considered.

Response to Amendment

2. Examiner approves the amendment to the abstract of the disclosure. The objection to the abstract of the disclosure is withdrawn.
3. Examiner approves the amendment to the specification. The objection to the drawings is withdrawn.
4. Regarding claim 8, Examiner points Applicant to column 31, lines 20-67, where the use of digital signatures and electronic certificates for verification and validation purposes is disclosed. Examiner has given the claim the broadest reasonable interpretation in light of the supporting disclosure.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 8-9, 16-18, 22, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Sehr (US Patent Number: US 6,386,451).

Regarding claim 8, Sehr teaches a method for verifying the authenticity of an electronic identification document, the method comprising: downloading the electronic document from a pervasive computing device (column 38, lines 33-35); decrypting the electronic document (column 42, lines 14-21); validating a digital certificate attached to the electronic document (column 1, lines 48-51, column 42, lines 14-21); verifying the authenticity of an electronic signature attached to the electronic document (column 18, lines 30-35); encrypting the electronic document (column 1, lines 48-51); and uploading the electronic document back to the pervasive computing device (column 22, lines 22-32); wherein the electronic document is a legally valid form of identification (column 43, lines 49-53).

Regarding claim 9, Sehr teaches wherein the electronic document is a passport (column 32, lines 13-16).

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Regarding claim 16, Sehr teaches attaching a new digital certificate to the electronic document (column 31, lines 58-62).

Regarding claim 17, Sehr teaches wherein the electronic document is uploaded via the Bluetooth protocol (column 1, lines 40-44).

Regarding claim 18, Sehr teaches wherein the pervasive computing device may comprise any of the following: personal digital assistant; laptop computer; mobile phone; smart phone; and palm pilot (column 6, lines 19-24).

Regarding claim 22, Sehr teaches a computer program product in a computer readable medium for use in a data processing system (column 4, lines 16-22), for verifying the authenticity of an electronic identification document, the computer program product comprising: instructions for downloading the electronic document from a pervasive computing device (column 38, lines 33-35); instructions for decrypting the electronic document (column 42, lines 14-21); instructions for validating a digital certificate attached to the electronic document (column 1, lines 48-51, column 42, lines 14-21); instructions for verifying the authenticity of an electronic signature attached to the electronic document (column 18, lines 30-35); instructions for encrypting the electronic document (column 1, lines 48-51); and instructions for uploading the electronic document back to the pervasive computing device (column 22, lines 22-32); instructions for wherein the electronic document is a legally valid form of identification (column 43, lines 49-53).

Regarding claim 25, Sehr teaches a system for verifying the authenticity of an electronic identification document, the method comprising: a first

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communication component which downloads the electronic document from a pervasive computing device (column 38, lines 33-35); a decrypting component which decrypts the electronic document (column 42, lines 14-21); a validation component which validates a digital certificate attached to the electronic document (column 1, lines 48-51, column 42, lines 14-21); a verification component which verifies the authenticity of an electronic signature attached to the electronic document (column 18, lines 30-35); an encrypting component which encrypts the electronic document (column 1, lines 48-51); and a second communication component which uploads the electronic document back to the pervasive computing device (column 22, lines 22-32); wherein the electronic document is a legally valid form of identification (column 43, lines 49-53).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-3, 6, 10, 13-15, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sehr.**

Regarding claim 1, Sehr teaches a method for creating an electronic identification document (column 1, lines 18-23), the method comprising: providing an electronic document to a user, wherein the electronic document contains input fields for personal identification information (column 1, lines 54-59); receiving the user's personal identification information in the input fields of the electronic document (column 1, lines 60-65); receiving an electronic signature from the user, and attaching the electronic signature to the electronic document (column 6, lines 55-58); adding an electronic certificate to the electronic document (column 1, lines 48-51); encrypting the electronic document (column 1, lines 48-51); and uploading the electronic document to a pervasive computing device (column 32, lines 16-21); wherein the electronic document is a legally valid form of identification (column 43, lines 49-53). Sehr does not expressly disclose after adding the electronic certificate to the electronic document, encrypting the electronic document which contains the added electronic certificate. However, Sehr teaches using the electronic certificate for verifying the authenticity of the

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document (column 31, lines 20-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt the electronic document which contains the added electronic certificate after adding the electronic certificate to the electronic document. One of ordinary skill in the art would have been motivated to do so because it was well known in the art at the time the invention was made to use electronic certificates to verify authenticity of documents.

Regarding claim 2, Sehr teaches wherein the electronic document is a passport (column 32, lines 13-16).

Regarding claim 3, Sehr does not expressly disclose wherein the electronic document contains a unique serial number from an issuing authority that uniquely identifies the electronic document. However, Examiner takes Official Notice that the use of passports having a unique number issued by an issuing authority was conventional and well known, there is at most one passport issued by an issuing authority with a given serial number. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to create an electronic identification document containing a unique serial number from an issuing authority since Examiner takes Official Notice that it was conventional and well known.

Regarding claim 6, Sehr teaches wherein the pervasive computing device may comprise any of the following: mobile phone; and smart phone (column 6, lines 19-24).

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Regarding claim 10, Sehr does not expressly disclose wherein the electronic document contains a unique serial number from an issuing authority that uniquely identifies the electronic document. However, Examiner takes Official Notice that the use of passports having a unique number issued by an issuing authority was conventional and well known, there is at most one passport issued by an issuing authority with a given serial number. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to create an electronic identification document containing a unique serial number from an issuing authority since Examiner takes Official Notice that it was conventional and well known.

Regarding claim 13, Sehr does not expressly disclose changing information contained in the electronic document after decrypting the electronic document, wherein the changes are a part of the electronic document when the electronic document gets encrypted by the encrypting step. However, Examiner takes Official Notice that decrypting an electronic document, changing information contained in the electronic document, and re-encrypt it was conventional and well known. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to decrypt the document, change it, and re-encrypt it since Examiner takes Official Notice that it was conventional and well known.

Regarding claim 14, Sehr does not expressly disclose attaching new information to the electronic document after decrypting the electronic document, wherein the new information is a part of the electronic document when the

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electronic document gets encrypted by the encrypting step. However, Examiner takes Official Notice that decrypting an electronic document, attaching new information, and re-encrypt it was conventional and well known. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to decrypt the document, attach new information, and re-encrypt it since Examiner takes Official Notice that it was conventional and well known.

Regarding claim 15, Sehr teaches wherein the information attached to the electronic document is a visa (column 44, lines 33-36).

Regarding claim 19, Sehr teaches a method for creating an electronic identification document (column 1, lines 18-23), the method comprising: receiving an electronic document, wherein the electronic document contains input fields for personal identification information (column 1, lines 54-59); entering personal identification information in the input fields of the electronic document (column 1, lines 54-59); entering an electronic signature, wherein the electronic signature is attached to the electronic document (column 6, lines 55-58); and downloading the electronic document to a pervasive computing device (column 32, lines 16-21), wherein the electronic document is encrypted and includes an electronic certificate (column 1, lines 48-51); wherein the electronic document is a legally valid form of identification (column 43, lines 49-53). Sehr does not expressly disclose wherein the electronic document includes an encrypted electronic certificate. However, Sehr teaches using electronic certificate for verifying the authenticity of the document (column 31, lines 20-67). Therefore, it would have

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been obvious to one having ordinary skill in the art at the time the invention was made to use an encrypted electronic certificate. One of ordinary skill in the art would have been motivated to do so because it was well known in the art at the time the invention was made to use electronic certificates and encryption to verify authenticity of documents.

Regarding claim 20, Sehr teaches uploading the electronic document from the pervasive computing device (column 38, lines 33-35); decrypting the uploaded electronic document (column 19, lines 5-37, column 30, lines 60-67, column 31, lines 1-67); validating the digital certificate attached to the decrypted electronic document (column 31, lines 20-67); and verifying the authenticity of the electronic signature attached to the decrypted electronic document (column 31, lines 20-67).

Regarding claim 21, Sehr teaches a computer program product in a computer readable medium for use in a data processing system, for creating an electronic identification document (column 4, lines 16-22), the computer program product comprising: instructions for providing an electronic document to a user, wherein the electronic document contains input fields for personal identification information (column 1, lines 54-59); instructions for receiving the user's personal identification information in the input fields of the electronic document (column 1, lines 60-65); instructions for receiving an electronic signature from the user, and attaching the electronic signature to the electronic document (column 6, lines 55-58); instructions for adding an electronic certificate to the electronic document (column 1, lines 48-51); instructions for uploading the electronic document to a

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pervasive computing device (column 32, lines 16-21); wherein the electronic document is a legally valid form of identification (column 43, lines 49-53). Sehr does not expressly disclose instructions for encrypting the electronic document which contains the added electronic certificate. However, Sehr teaches using the electronic certificate for verifying the authenticity of the document (column 31, lines 20-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt the electronic document which contains the added electronic certificate. One of ordinary skill in the art would have been motivated to do so because it was well known in the art at the time the invention was made to use electronic certificates and encryption to verify authenticity of documents.

9. Claims 4-5 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sehr as applied to claim 1 above, and further in view of Rhoads (US Patent Number: 6,345,104).

Regarding claims 4 and 11, Sehr does not expressly disclose wherein the electronic document contains a digital watermark that can be used to detect an illegal copy of the electronic document. However, Rhoads teaches using digital watermarks to detect counterfeiting (column 22, lines 25-65). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a digital watermark with the identification document of Sehr. One of ordinary skill in the art would have been motivated to do so because it was well known in the art to use digital watermarks to detect counterfeit documents (Rhoads, column 22, lines 25-65).

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Regarding claims 5 and 12, Sehr does not expressly disclose wherein the electronic document comprises an authorization seal from the issuing authority that is displayed by the pervasive computing device to verify authenticity of the electronic document. However, Rhoads teaches the use of seals from issuing authorities (column 3, lines 1-26). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the seal of an issuing authority with the identification document of Sehr. One of ordinary skill in the art would have been motivated to do so because it was well known in the art to use the seal of an issuing authority with identification documents (Rhoads, column 1, lines 1-26).

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sehr as applied to claim 1 above, and further in view of Loeb et al. (US Patent Number: 6,014,641).

Regarding claim 7, Sehr does not expressly disclose wherein the electronic document is renewed automatically at set time intervals. However, Loeb et al. teach the use automatic renewals at set time intervals (column 2, lines 15-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to automatically renew the document of Sehr. One of ordinary skill in the art would have been motivated to do so because it was well known in the art to use automatic renewals.

11. Claims 23-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sehr, and further in view of Rhoads.

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Regarding claim 23, Sehr teaches a computer program product in a computer readable medium for use in a data processing system (column 4, lines 16-22), for creating an electronic identification document, the computer program product comprising: instructions for receiving an electronic document, wherein the electronic document contains input fields for personal identification information (column 1, lines 54-59); instructions for entering personal identification information in the input fields of the electronic document (column 1, lines 54-59); instructions for entering an electronic signature, wherein the electronic signature is attached to the electronic document (column 6, lines 55-58); and instructions for downloading the electronic document to a pervasive computing device (column 32, lines 16-21), wherein the electronic document is encrypted and includes an electronic certificate (column 1, lines 48-51); wherein the electronic document is a legally valid form of identification (column 43, lines 49-53). Sehr does not expressly disclose wherein the electronic document includes an encrypted electronic certificate. However, Sehr teaches using electronic certificate for verifying the authenticity of the document (column 31, lines 20-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use an encrypted electronic certificate. One of ordinary skill in the art would have been motivated to do so because it was well known in the art at the time the invention was made to use electronic certificates and encryption to verify authenticity of documents.

Regarding claim 24, Sehr teaches a system for creating an electronic identification document, the system comprising: a first communication component

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which provides an electronic document to a user, wherein the electronic document contains (i) input fields for personal identification information (column 1, lines 54-59); a first receiving component which receives the user's personal identification information in the input fields of the electronic document (column 1, lines 60-65); a second receiving component which receives an electronic signature from the user, and attaches the digital signature to the electronic document (column 6, lines 55-58); a register which adds an electronic certificate to the electronic document (column 1, lines 48-51); an encrypting component which encrypts the electronic document (column 1, lines 48-51); and a second communication component which uploads the electronic document to a pervasive computing device (column 32, lines 16-21); wherein the electronic document is a legally valid form of identification (column 43, lines 49-53). Sehr does not expressly disclose wherein the electronic document contains (ii) a unique serial number from an issuing authority that uniquely identifies the electronic document. However, Examiner takes Official Notice that the use of passports having a unique number issued by an issuing authority was conventional and well known, there is at most one passport issued by an issuing authority with a given serial number. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to create an electronic identification document containing a unique serial number from an issuing authority since Examiner takes Official Notice that it was conventional and well known. Sehr does not expressly disclose wherein the electronic document contains (iii) a digital watermark that can be used to detect an illegal copy of the electronic

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document. However, Rhoads teaches using digital watermarks to detect counterfeiting (column 22, lines 25-65). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a digital watermark with the identification document of Sehr. One of ordinary skill in the art would have been motivated to do so because it was well known in the art to use digital watermarks to detect counterfeit documents (Rhoads, column 22, lines 25-65).

Regarding claim 26, Sehr teaches a system for creating an electronic identification document, the system comprising: a receiving mechanism which receives an electronic document, wherein the electronic document contains (i) input fields for personal identification information (column 1, lines 54-59); a first input component which enters personal identification information in the input fields of the electronic document (column 1, lines 60-65); a second input component which enters an electronic signature wherein the electronic signature is attached to the electronic document (column 6, lines 55-58); and a downloading mechanism which downloads the electronic document to a pervasive computing device (column 32, lines 16-21), wherein the electronic document is encrypted (column 1, lines 48-51) and includes an electronic certificate (column 1, lines 48-51); wherein the electronic document is a legally valid form of identification (column 43, lines 49-53). Sehr does not expressly disclose wherein the electronic document contains (ii) a unique serial number from an issuing authority that uniquely identifies the electronic document. However, Examiner takes Official Notice that the use of passports having a

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unique number issued by an issuing authority was conventional and well known, there is at most one passport issued by an issuing authority with a given serial number. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to create an electronic identification document containing a unique serial number from an issuing authority since Examiner takes Official Notice that it was conventional and well known. Sehr does not expressly disclose wherein the electronic document contains (iii) a digital watermark that can be used to detect an illegal copy of the electronic document. However, Rhoads teaches using digital watermarks to detect counterfeiting (column 22, lines 25-65). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a digital watermark with the identification document of Sehr. One of ordinary skill in the art would have been motivated to do so because it was well known in the art to use digital watermarks to detect counterfeit documents (Rhoads, column 22, lines 25-65). Sehr does not expressly disclose wherein the electronic document includes an encrypted electronic certificate. However, Sehr teaches using electronic certificate for verifying the authenticity of the document (column 31, lines 20-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use an encrypted electronic certificate. One of ordinary skill in the art would have been motivated to do so because it was well known in the art at the time the invention was made to use electronic certificates and encryption to verify authenticity of documents.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David G. Cervetti whose telephone number is (571) 272-5861. The examiner can normally be reached on Monday-Friday 7:00 am - 5:00 pm, off on Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DGC



AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100